

### **REMARKS**

As a result of this amendment, claims 1-21 are now pending in this application.

#### **Response to Claim Objections**

Claim 9 was subject to an objection for omitting a period after “authority.” Applicant has amended the claim to include the missing period, and therefore requests respectfully that the Examiner withdraw the objection.

#### **Response to §102 Rejections**

The Examiner rejected claims 1-14 under 35 U.S.C. §102(b) for anticipation by Rivette (U.S. Patent 5,991,751). In response, applicant submits respectfully that Rivette does not identically teach each and every limitation of the claims 1-9, and 14 as amended or of claim 10-13 as originally presented..

For example, claim 1 has been amended to recite that “the first database including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second database including case opinions, court documents, law review articles, statutory materials, and legislative histories.” A computerized search of Rivette’s text reveals no occurrences of the terms “brief,” “opinion,” “advisory,” “memorandum,” or “memoranda.” Thus, it does not appear that one of ordinary skill would regard it as identically meeting this limitation of claims 1-9.

Additionally, claim 1 further requires that the first database be “part of an information-management system for the law firm” and that the second database be “external to the information management system of the law firm.” Rivette does not appear to meet this requirement either.

For at least these reasons, applicant requests respectfully that the Examiner reconsider and withdraw the §102 rejection of claims 1-9.

Regarding claims 10-12, applicant submits respectfully that it has been amended to recite that the internal law firm content includes briefs, client correspondence, advisory opinions, or legal memoranda., none of which are taught by Rivette. For at least this reason, applicant

requests respectfully that the Examiner reconsider and withdraw the §102 rejection of claims 10-12.

Claim 13 also appears to distinguish from Rivette. For example, claim 13 requires a browser-compatible interface that enables access to work product documents stored in a law-firm information management system and external case law documents. Rivette provides nothing teaching about access to any case law documents. Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §102 rejection of claim 13

#### **Response to Withdrawal of Claims 15-21**

In the Action, the Examiner deemed claims 15-21 to be withdrawn, stating that they are directed to an independent invention and that an Action on the merits was previously presented. However, applicant submits respectfully that the present Action is the first Action on the merits, with the prior Action being a Restriction Requirement. Moreover, conceptually each of the limitations within claim 15 appears within various claims of the prior elected Group. For example, first and second databases are recited in claim 1; pay-for-access is recited in claim 3; user interface and single query are recited in claims 10-13. A similar correlation exists for the other claims in the withdrawn claims.

Accordingly, applicant requests respectfully that the Examiner examine these claims on the merits.

#### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are

relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request joinder of any withdrawn claim, as required by MPEP § 821.04.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9593 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

FORREST RHOADS ET AL.

By their Representatives,

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By 

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15 day of June 2007.

Name

  
Signature